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10/668,785	09/23/2003	Troy M. Just		4104
31083 7590 08/09/2007 THOMTE LAW OFFICE, L.L.C. 2120 S. 72ND STREET, SUITE 1111 OMAHA, NE 68124			EXAMINER HAND, MELANIE JO	
			ART UNIT 3761	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/668,785  
Filing Date: September 23, 2003  
Appellant(s): JUST, TROY M.

**MAILED**  
**AUG 09 2007**  
**GROUP 3700**

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Dennis L. Thomte  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed March 21, 2007 appealing from the Office action mailed May 19, 2006.

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**(1) Real Party in Interest**

The real party in interest is HTI Plastics.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,364,854

FERRER ET AL

4-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 8, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrer et al (U.S. Patent No. 6,364,854).

With respect to **Claims 1,8**: Ferrer teaches vaginal medication applicator 10 comprising main tubular body 20 having an inner surface, plunger 30, piston 40 and cap 50. Main body 20 has a closed dispensing end 21 with a plurality of openings 26 and an open grasping end 22. Piston 40 is slidably mounted on a rod within said main body 20 and is therefore capable of being selectively positioned. Piston 40 fits snugly within section 23 of the main applicator body and provides a closure to the compartment wherein medication is stored and has sealing flange 43 disposed on its outer surface that engages with the inner surface of section 23 of body 20. As can best be seen in Fig. 5, an opening 45 is present in piston 40 to accept plunger 30 and this opening terminates between the first and second ends of said piston. Plunger 30 and piston 40 are configured so as to fit together to form the impeller system for dispensing the medication outward from said body 20. Plunger 30 has inner end 31 that is always housed inside body 20 and is slidably engageable with piston 40. Piston 40 has an outer diameter that is larger than body 20 due to the presence of flange 43, therefore said piston is in a compressed state whenever it is disposed within body 20. Due to this compression, upon application of force to piston 40 by plunger 30, piston 40 is pushed along body 20 toward dispensing end 21 while

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being longitudinally stretched. Pairs of elements 46-35 and 47-34 act to retain the piston in an engaged position at one end of the plunger, allowing discharge of medication and preventing accidental disassembly of the plunger-piston system while the applicator is being used. (Col. 2, lines 51-65, Col. 4, lines 14-17, 20-27, 36-40, 49-53, 57-67, Col. 5, lines 22, 23, 28-35, Col. 7, lines 11,12)

Ferrer teaches that the piston and plunger are an effectively unitary impeller means in that when the applicator is manufactured, the piston and plunger are assembled together in an engaged configuration. Therefore, when the impeller means is advanced to propel medication out of the end of the applicator, both the piston and the plunger remain in the barrel to ensure that the applicator is not re-usable. Ferrer thus does not explicitly teach that the plunger as it exists within an assembled applicator, is detachably connected to the piston in such a manner as to be capable of being disconnected from said piston, thereby leaving the piston in the main body portion. However, it would be obvious to one of ordinary skill in the art to modify the applicator of Ferrer to be manufactured separately from the piston in such a way as to allow the plunger to disconnect from the piston upon completion of use, as these pieces are manufactured separately and are capable of being assembled separately as an alternative means of assembling that produces a substantially identical product to the claimed invention. Rejection under 35 U.S.C. 103 is indicated where prior art discloses product that appears to be either identical with or only slightly different from product claimed in product-by-process claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

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With respect to **Claims 2,10**: Ferrer teaches that piston 40 fits snugly within portion 23 of body 20 and is thus receivable in openings 26. (Col. 4, lines 19,20)

With respect to **Claims 3,11**: Piston 40 and plunger 30 are assembled together and are constructed in a complementary manner such that plunger 30 having rib 34 and groove 35 engage piston 40 via orifice 45 to temporarily hold the piston 40 in place during movement of the rod-piston structure, forming an effectively unitary impeller structure. Therefore, application of a certain amount of force against the first end of the plunger 30 that is disposed within orifice 45 of piston 40 will result in the destruction of the impeller system, thus ensuring that the applicator cannot be reused.

#### **(10) Response to Argument**

Appellant's arguments filed March 21, 2007 have been fully considered but they are not persuasive.

With respect to appellant's arguments regarding the rejection of claims 1-3, 8, 10 and 11 over Ferrer: Appellant argues that Ferrer does not teach or suggest a plunger that will separate from a piston or a piston that will rupture if pushed through the dispensing end. Piston 40 of Ferrer is slidably engageable with rod 31, and thus also plunger 30, via a hole 45 extending therethrough and terminating between the first and second end of said piston 40 as can be seen in Fig. 5 of Ferrer. There is absolutely nothing taught by Ferrer that holds the rod 31 in the opening 45 such that it cannot be detachably connected at a later time, e.g. after dispensation of medication. The Office acknowledges that it is stated in the previous Office action mailed May 19, 2006 that "Ferrer teaches that piston 40 and plunger 30 are assembled together and are constructed in a complementary manner such that plunger 30 having rib 34 and groove 35

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engage piston 40 via orifice 45 to lock the piston 40 in place, forming an effectively unitary impeller structure.” It is clarified in this Office action that the rod is not locked in place such that it is not ever detachably connected, merely that the rod is held in place while the rod-piston structure dispenses medication, to be detachable at a later time from the piston 40. The rejection has been restated to reflect this clarification. The limitation that the piston 40 remain in the barrel structure 20 after the plunger detaches flows necessarily from the teachings of Ferrer that the rod is detachably connected at some subsequent point in time and the teaching that the piston 40 is actually larger in diameter than the barrel but is flexible. (Col. 2, lines 59,60) Once the rod 31, which applies the force to the piston that pushes and compresses it is detached, the piston 40 will necessarily return to its normal size and thus will remain inside the barrel after the rod and plunger detach therefrom. Therefore the rod 31 and plunger 30 are considered herein to be fairly suggested by Ferrer as being detachably connected to piston 40 upon application of force as in the claimed invention. As to a piston that is ruptured if the rod-piston structure attempts to push the piston 40 forwardly through the dispensing end after medication has been dispensed, it is noted that the features upon which appellant relies (i.e., a piston that is ruptured if an attempt is made to push the piston forwardly through a dispensing end) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As to appellant's argument that the claimed invention is not obvious over Ferrer, the Office believes that the response *supra* regarding whether Ferrer teaches a plunger that detachably connects from a position also addresses the argument of whether the claimed invention is obvious over Ferrer.

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Appellant's arguments with regard to dependent claims 2,3,8,10 and 11 have been fully considered but are not persuasive as Appellants' arguments depend entirely on Appellant's arguments regarding the rejection of claim 1, which have been addressed *supra*.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



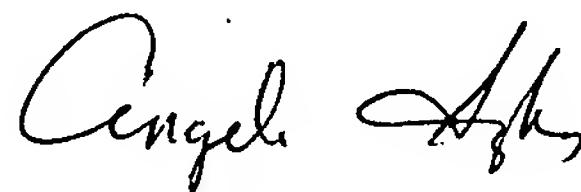
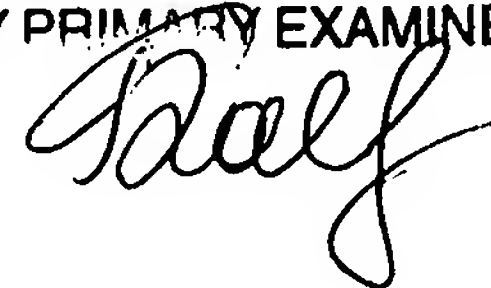
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